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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,753	02/16/2006	Hiromi Nambu	271767US0PCT	1649
22850 7590 09/04/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER MERCIER, MELISSA S				
ART UNIT 1615		PAPER NUMBER		
NOTIFICATION DATE 09/04/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/534,753

Applicant(s)

NAMBU ET AL.

Examiner

MELISSA S. MERCIER

Art Unit

1615

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 11, 17, 22-28 and 30-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 11, 17, 22-28 and 30-41 is/are rejected.
- 7) ☒ Claim(s) 42-45 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/888)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Receipt of Applicants Amendment and Amended Claims filed on May 5, 2008 is acknowledged. Claims 1, 11, 17, 22-28, 30-45 are pending in this application. Rejections and/or objections not reiterated from previous Office Actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claim Objections

Claims 42-45 are objected to as being dependent upon a rejected base claim.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 11, 17, 22-28, and 30-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masashi et al. (AU-B-25757/95) in view of Shin (US Patent 4,937,069).

Masashi discloses water absorbent resin particles comprising water absorbent resin particles (A) which are a cross linked polymer of ethylenically unsaturated monomers comprising acrylic acid and/or acrylic acid salt as an essential element, treated with an organic polysiloxane (B), wherein (A) and (B) are mixed and/or reacted,

the particles have a particle size of 10-1000um and the weight ratio of (A)/(B) is 100/(0.001-5) (abstract).

Masashi further discloses since the surface of (A) particles is improved with (B) liquid organic polysiloxane, the water absorbent resin particles have an improved hygroscopic blocking rate in a high humidity and obtain a wettability to prevent the generation of dust. Additionally, since the conventional disadvantage of disturbing uniform penetration of water caused by bonding of water-absorbent particles each other is improved by the modification effect of (B) in this invention, the absorption rate is improved.

Examples of such water-absorbent resins (A) include cross linked partially neutralized polyacrylic acid, self-cross linked partially neutralized polyacrylic acid, cross linked graft-copolymers of starch-acrylic acid salt, hydrolyzed cross linked graft-polymers of starch-acrylonitrile, cross linked copolymers of vinyl alcohol-acrylic acid salt, hydrolyzed cross linked copolymers of acrylic acid-acrylamide, hydrolyzed cross linked copolymers of acrylic acid salt-acrylonitrile, cross linked copolymers of acrylic acid salt and 2-acrylamide-2-methyl propane sulfonate, neutralized cross linked copolymers of isobutylene-maleic anhydride, and mixture of two or more of these examples (page 7, 2nd paragraph).

In the case when the above cross linked polymers shown are examples of water absorbent resins (A) are formed with carboxylic salts such as acrylic salt as a raw material, or when they form salts as a neutralized product or a partially neutralized

product, examples of such salts include sodium salt, potassium salt, ammonium salt, and amine salt (page 7, last paragraph through page 8, top paragraph).

Preferable organic polysiloxane compounds include amino-modified silicone oil such as the amino-modified silicone oil (see page 11 chemical structures).

The particles may be admixed with fillers or additives including organic powders, natural polysaccharides, inorganic powders, including alumina, antioxidants, antiseptic agents, disinfectants, surface active agents, coloring agents, perfumes and deodorants (page 21, top paragraph).

Since Masashi teaches the same polymer particles claimed in the instant application, absent a showing to the contrary, it is the position of the examiner that the particles would have the same functional limitations of claims 11 and 14.

Masashi does not disclose the use of an anti-perspiring component admixed with his particles, a carrier for a cosmetic composition, or a method of controlling perspiration.

Shin discloses an antiperspirant suspension comprising astringent aluminum or zirconium compounds or complexes or mixtures thereof. Typical antiperspirant actives include impalpable aluminum chlorohydroxide and aluminum hydroxy-bromide, aluminum chloride as well as the aluminum/zirconium/glycine antiperspirant complexes (column 2, lines 50-63). Shin additionally discloses the use of thickening/solid emollients including cyclomethicone (column 5, lines 9-28). Based on a review of the instant examples on page 45 of the specification, 39.2% to 43.2% by weight of the composition

is cyclomethicone. The examiner is interpreting the claimed carrier to be the cyclomethicone.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have selected specific aluminum, zirconium, and zinc components, including chlorohydroxides, disclosed by Shin, with the water absorbing particles of Masashi in order to make the cosmetic composition capable of controlling perspiration since Masashi discloses the excellent absorption qualities of the particles the water absorbent resin particles have an improved hygroscopic blocking rate in a high humidity and obtain a wettability to prevent the generation of dust.

Response to Arguments

Applicant's arguments filed May 5, 2008 have been fully considered but they are not persuasive. Applicant has argues "the Office is of the opinion that previously presented Claim 1 is rendered obvious by Masashi (AU 25757/95). Applicants point out that Masashi does not disclose any composition containing an antiperspirant. Applicants submit that because Masashi does not disclose or suggest all of the present claim limitations, the presently-claimed invention cannot be obvious over Masashi and the Office Action includes a citation to Shin (U.S. 4,937,069) but it is unclear whether the Office has combined Masashi and Shin in the rejection of previously presented claim 1. Applicants attention is drawn to the rejection of record, where it is clearly stated the claims are rejected over Masashi in view of Shin and further discloses that Masashi does not disclose the use of an anti-perspiring component admixed with his particles, a carrier for a cosmetic composition, or a method of controlling perspiration. Therefore, it

is unclear to the examiner where Applicant is alleging a lack of clarity in the office action.

Applicant further argues Shin does not include any reference or suggestion to water absorbent polymer particles. Further, Shin's cyclomethicone is not a silicone having a functional group and thus does not suggest the surface hydrophobated water-absorbing polymer particles coated thereon with a silicone compound having at least one kind of functional group. Again Applicants attention is drawn to the rejection of record in which it is acknowledged the cyclomethicone is interpreted as a carrier. The particles coated thereon with a silicone compound having at least one kind of functional group are disclosed by the Masashi reference. It is further submitted, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

As suggested during the interview on April 1, 2008, it is again recommended Applicant submit some form of unexpected results if available.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 11, 17, 22-28, and 30-45 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 8, 10, 12, 15, and 24 of copending Application No. 10/137,405 in view of Shin (US Patent 4,937,069). The copending application claims a cosmetic composition comprising polymer particles using comprising terminology in the claims. The instant application

comprises the same polymer particles and an antiperspirant component. The teachings of Shin are discussed above. Shin is relied on for specific antiperspirant metal compounds. It would have been obvious to a person of ordinary skill in the art to have incorporated the antiperspirant components of Shin since the particles are disclosed as being water absorbing and Shin discloses a composition for controlling perspiration. This is a provisional obviousness-type double patenting rejection.

Response to Arguments

Applicant's arguments filed May 8, 2008 have been fully considered but they are not persuasive. The claims of the co-pending application are drawn to a silicone-modified water-absorbing polymer particle (see Claim 8) and a cosmetic composition comprising the particle (see Claim 24). Applicants submit that the subject matter of the present claims (e.g., drawn to compositions that are in the form of a stick antiperspirant or which contain a major amount of a silicone) should not be rejected for obviousness-type double patenting over the co-pending application. The claims of the co-pending application are drawn to a particle or a composition. Nowhere in the claims of the co-pending application is a composition in the form of a stick antiperspirant or in the form of a composition comprising a major amount of silicone disclosed therefore the present claims should be allowed over the co-pending claims. The examiner agrees with Applicants assessment of the differences between the copending claims. However, the double patenting rejection is over the copending rejection in view of the Shin reference and not the copending application alone.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELISSA S. MERCIER whose telephone number is (571)272-9039. The examiner can normally be reached on 8:00am-4:30pm Mon through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Melissa S Mercier/
Examiner, Art Unit 1615

/MP WOODWARD/
Supervisory Patent Examiner, Art Unit 1615